ESTTA Tracking number: **ESTTA695484**

Filing date: **09/11/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91210506
Party	Defendant E! Entertainment Television, LLC
Correspondence Address	MICHAEL J MCCUE LEWIS ROCA ROTHGERBER LLP 3993 HOWARD HUGHES PKWY, STE 600 LAS VEGAS, NV 89169-5996 UNITED STATES Trademarks-LasVegas@LRRLaw.com, MMcCue@LRRLaw.com, JFountain@LRRLaw.com
Submission	Other Motions/Papers
Filer's Name	Jonathan W. Fountain
Filer's e-mail	Trademarks-LasVegas@LRRLaw.com,MMcCue@LRRLaw.com,JFountain@LRRLaw.com
Signature	/Jonathan W. Fountain/
Date	09/11/2015
Attachments	91210506 2015.09.11 Motion for Leave to Withdraw Admissions.pdf(33578 bytes) 91210506 2015.09.11 Declaration of Jonathan W. Fountain ISO M for Lv to Wdraw Admissions.pdf(16044 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

OVATION, LLC, a Delaware limited liability company, Opposer, v. E! ENTERTAINMENT TELEVISION, LLC, a Delaware limited liability company, Applicant.	**Opposition No. 91210506 (parent)** Application No. 85/569,798 Mark: POP OF CULTURE **Opposition No. 91217286** Application No. 85/937,423 Mark: E POP OF CULTURE **Opposition No. 91217287** Application No. 85/937,399 Mark: E POP OF CULTURE

APPLICANT E! ENTERTAINMENT TELEVISION, LLC'S
MOTION FOR LEAVE TO WITHDRAW ADMISSIONS

Applicant E! Entertainment Television, LLC ("Applicant" or "E!") hereby requests leave to withdraw any deemed admissions to Opposer Ovation, LLC's ("Opposer's" or "Ovation's") requests for admissions served on February 12, 2014. This motion is supported by the Declaration of Jonathan W. Fountain (the "Fountain Decl."), the legal arguments set forth below, and the record in this case.

PRELIMINARY STATEMENT

On September 2, 2015, the Board, through Interlocutory Attorney Elizabeth J. Winter, granted in-part and denied in-part Ovation's motion to compel. (Dkt. No. 32.) As part of the ruling, the Board deemed moot Ovation's motion to test the sufficiency of E!'s responses to Ovation's requests for admissions because the Board *sua sponte* concluded that E! had not timely responded to the requests for admissions and, therefore, they were admitted. The Board

reasoned that, because E!'s prior request for an extension of time to serve responses to Ovation's discovery requests served on January 24, 2014, did not specifically mention Ovation's requests for admissions (which had been served a couple of weeks later on February 12, 2014) that E!'s request for an extension of time did not apply to Ovation's requests for admissions. The Board ruled *sua sponte* that the requests were deemed admitted as a matter of law by operation of Rule 36 of the Federal Rules of Civil Procedure, even though Ovation did not seek that relief in its motion. More specifically, the Board found that E!'s deadline to respond to the requests was April 9, 2014, but that E! responded on May 9, 2014, when E! responded to Ovation's other discovery requests. The impact of this ruling was that the Board deemed 117 requests for admissions admitted, many of which go to the central issues in dispute.

Under the circumstances, the Board should grant leave to withdraw these "admissions" under TBMP § 407.03(a), TBMP § 525, and Federal Rule of Civil Procedure 36(b). As discussed below, allowing the admissions to remain would not promote adjudication on the merits as many, if not all, of the central issues in the case would be deemed admitted. Furthermore, allowing E! to withdraw these "admissions" would not prejudice Ovation because discovery has not closed and the testimony period has not begun.

FACTUAL BACKGROUND

I. The Parties.

E! is a cable and satellite television channel that features programming about entertainment, the entertainment industry and pop culture in general. (Fountain Decl. ¶ 3.) POP OF CULTURE is E!'s tagline, which it adopted, followed a re-branding of E! in July, 2012. (*Id.*)

On April 29, 2103, Ovation opposed registration of the POP OF CULTURE mark on the grounds of alleged confusion with Ovation's CULTUREPOP mark, a mark it uses for the name

of a cable television show about pop culture. (Fountain Decl. ¶ 4.) On July 9, 2014, Ovation filed notices of opposition to two of E!'s applications to register the E POP OF CULTURE mark. (*Id.*) On October 11, 2014, these three opposition proceedings were consolidated. (*Id.*)

II. E! Serves Its First Set of Discovery Requests; Ovation Serves Its First Set of Discovery Requests, But Does So On Separate Days.

On November 12, 2013, E! served a set of discovery requests on Ovation. (Fountain Decl. ¶ 5.) On January 24, 2014, Ovation served E! with 33 interrogatories and 82 requests for production of documents. (*Id.* ¶ 6.) Shortly thereafter, on February 12, 2014, Ovation served E! with 117 requests for admissions. (*Id.*)

III. Ovation Declines to Grant E! An Extension of Time To Respond to Ovation's First Set of Discovery Requests.

Between November 2013 and March 2014, E!'s counsel and Ovation's counsel granted each other numerous reciprocal extensions of time to respond to the pending discovery requests to accommodate ongoing settlement discussions. (*Id.* ¶ 7.) E!'s motion to compel, filed on April 9, 2014, detailed these extensive discussions. (*Id.* (citing Dkt. No. 13).)

On February 14, 2014, E!'s counsel emailed Ovation's counsel, and proposed that the parties discuss settlement and the need for discovery responses from both parties. (*Id.* ¶ 8 (citing Dkt. No. 13, Ex. A to Declaration of Michael J. McCue In Support of Applicant's Motion to Compel).) In that email, E!'s counsel, Mr. McCue, proposed a suspension of the proceedings to allow the parties to engage in settlement, including a proposal that E! would serve its responses to "Ovation's **first set** of written discovery requests" within 45 days after proceedings resume. (*Id.*) (Emphasis added.) After receiving no response, E!'s counsel followed up regarding this request on February 24, 2014, March 14, 2014, and March 27, 2014. (*Id.*) In his March 27 email, E!'s counsel asked for an extension of time to "respond to Ovation's **discovery requests**" from April 4 to April 29, while E! waited for a response on the proposed settlement

procedures. (*Id.*) (Emphasis added.) Finally, on March 28, 2014, Ovation replied that it would prefer to have the responses to Ovation's discovery requests, including E!'s responses to Ovation's requests for admissions, before discussing settlement. (*Id.*) Ovation offered to give E! an extension of time of 5 days to respond to its discovery requests from April 4 to April 9, 2014. (*Id.*)

On March 31, 2014, E!'s counsel conveyed his dismay over Ovation's refusal to grant a longer extension of time. (*Id.* ¶ 9.) However, E!'s counsel accepted the April 9, 2014 extension of time to respond to all of Ovation's outstanding discovery requests, including its requests for admissions. (*Id.*)

IV. E! Moves The Board For An Extension of Time To Respond To Ovation's Discovery Requests, But Mentions Only One Of The Dates When The Discovery Requests Were Served.

On April 9, 2014, E! filed a motion to compel Ovation to serve responses to E!'s discovery requests, and also asked the Board to grant E! an extension of time "to serve its written objections and responses to Opposer's discovery requests by 30 days." (Fountain Decl. ¶ 10 (citing Dkt. No. 13 at 2)). E!'s motion stated that it sought an extension of time for the "January 24, 2014" discovery requests. (*Id.*) As noted above, however, the first set of requests for admissions were served on February 12, 2014, apart from the interrogatories and request for the production of documents that had been served on January 24, 2014.

Ostensibly, it would appear that E! did not request an extension of time for responding to Ovation's 117 requests for admissions, but this was an inadvertent oversight. (Fountain Decl. ¶ 11.) As seen from the email communications leading to E!'s motion seeking an extension of time, it was clear that E! sought an extension of time from Ovation to respond to Ovation's entire "first set" of discovery requests, which included Ovation's requests for admissions. (*Id.* (citing

Dkt. No. 13, Ex. A to McCue Decl., Feb. 14, 2014 Email from McCue to Pietrini).) Indeed, Ovation clearly thought the same thing, as Ovation granted E!'s request for an extension of time to respond to all of Ovation's outstanding discovery responses, from April 4 to April 9. (*Id.* (citing Dkt. No. 13, Ex. A to McCue Decl., March 28, 2014 Email from Walters to McCue; Dkt. No. 26, Ovation's Motion to Compel at n. 1 (arguing that E! did not timely respond by April 9, 2014).)

When Ovation refused to grant E! the extension of time it had asked for, E! intended to ask the Board for the same relief – an extension of time to respond to **all** of Ovation's outstanding discovery requests, including Ovation's requests for admissions. (Fountain Decl. ¶ 12.) However, E!'s counsel who drafted E!'s motion to compel and request for an extension of time for E! to respond to Ovation's "first set" of discovery requests inadvertently referred to the requests served on January 24, 2014 -- not realizing that the requests for admission had been served on a different date, February 12, 2014. (*Id.*)

The Board eventually granted E!'s request for an extension of time. (*Id.* ¶ 13 (citing Dkt. No. 18).) Consistent with the belief that E! asked for, and was granted, an extension of time to respond to **all** of Ovation's discovery requests, including the 117 requests for admissions, E! served its responses to Ovation's discovery requests, including its responses to the requests for admissions, within the time provided for by the Board (*i.e.*, on May 9, 2014). (*Id.*)

V. Ovation Moves to Compel And In A Footnote, Remarks It Is Not Waiving Its Belief That E! Did Not Timely Respond To The Requests For Admissions.

On April 3, 2015, Ovation filed a motion to compel. (Fountain Decl. ¶ 14 (citing Dkt. No. 26).) In the motion, Ovation asked the Board to test the sufficiency of E!'s May 9, 2014 responses to Ovation's requests for admissions. (*Id.*) In a footnote, in the "factual background" section of the motion, Ovation noted that by seeking to test the sufficiency of the responses,

Ovation did not waive its right to argue that E!'s responses were untimely because E! had not "expressly" sought an extension of time to respond to Ovation's requests for admissions because E!'s motion only specifically referenced the discovery Ovation served on "January 24":

> On July 31, 2014, the Board granted Applicant's motion over Opposer's opposition. (Docket No. 18.) This motion should not be construed as Opposer's waiver or rescission of the position it expressed in its opposition to Applicant's motion, that is, that Applicant waived its right to object to Opposer's discovery requests for its failure to serve timely responses. Furthermore, Applicant did not expressly seek any relief with respect to Opposer's RFAs or Applicant's responses thereto. Nowhere in its motion does Applicant refer to Opposer's RFAs, and, in fact, Opposer expressly only sought an extension of its deadline to respond to Opposer's "January 24, 2014 discovery requests," not Opposer's RFAs, which were served on February 12, 2014. (Docket No. 13, p. 22.) Thus, Opposer believes that, as a matter of law, each of Opposer's RFAs are deemed admitted for Applicant's failure to serve timely responses by April 9, 2014. *See* Fed.R.Civ.P. 36(a)(3). Opposer's instant motion to test the sufficiency of Applicants responses to certain of Opposer's RFA should not be construed as a waiver of Opposer's positon [*sic*].

(*Id*. ¶ 14 (citing Dkt. No. 26 at fn. 1).)

However, Ovation did <u>not</u> request that the Board find that Ovation's requests for admissions should be deemed admitted because E! had served untimely responses to the requests for admissions. (Fountain Decl. ¶ 15.)

E! responded on the merits to Ovation's request to test the sufficiency of E!'s responses. (*Id*. ¶ 16 (citing Dkt. No. 30).) E! noted that it believed the Board's previously granted extension of time for E! to respond to Ovation's discovery requests included an extension of time to respond to all of Ovation's outstanding discovery requests, including the requests for admissions. (*Id*. (citing Dkt. No. 30 at n. 1).)

VI. The Board Finds E!'s Responses To Ovation's Requests For Admissions Were Late And Thus, Admitted As a Matter of Law.

On September 2, 2015, the Board issued its decision on Ovation's motion to compel. (Fountain Decl. ¶ 17 (citing Dkt. No. 32).) The Board held Ovation's motion to test the

sufficiency of E!'s responses to Ovation's requests for admissions moot because, by failing to serve timely responses, E! had admitted the truth of the requests. (*Id*.) The Board's order states the following:

> ***Here, because Applicant did not serve its responses to Opposer's requests for admission until May 9, 2014, rather than April 9, 2014, and Applicant's motion to extend time did not apply to Opposer's requests for admission, Opposer's requests are deemed admitted.*** Fed. R. Civ. P. 36(a)(3). In view thereof, there was no need for Opposer to file its motion to test the sufficiency of Applicant's responses as they are not the operative responses in this matter… Accordingly, Opposer's motion to test the sufficiency of Applicant's responses is moot and will be given no further consideration.

(*Id*. (citing Dkt. No. 32 at 4) (emphasis added).)

E! now moves the Board for leave to withdraw these "admissions."

ARGUMENT

I. LEGAL STANDARD

The Board may grant leave to withdraw admissions that are deemed admitted due to an untimely response:

> If a party on which requests for admission have been served fails to timely respond thereto, the requests will stand admitted by operation of law ***unless*** the party is able to show that its failure to timely respond was the result of excusable neglect or unless a motion to withdraw or amend the admissions is filed pursuant to Fed. R. Civ. P. 36(b) and granted by the Board.

TBMP § 407.03(a).

Federal Rule of Civil Procedure 36(b) provides that the withdrawal of answers should be permitted, if doing so will "promote the presentation of the merits of the action" and "the court is not persuaded that it would prejudice the requesting party in maintaining or defending the action on the merits." *See also* TMBP § 525 (providing same language).

The board applies a two-pronged test for a party seeking to withdraw or amend its admissions. The first prong of the test is satisfied "when upholding the admissions would

practically eliminate any presentation of the merits of the case." *Giersch v. Scripps*, No. 92045576, 2007 WL 1653585, at *3 (T.T.A.B. June 6, 2007) (citing *Hadley v. United States*, 45 F.3d 1345, 1348 (9th Cir. 1995)). In other words, the proposed withdrawal or amendments must "facilitate the development of the case in reaching the truth." *Id.* (collecting cases).

Under the second prong of the test, the Board must examine "whether withdrawal [or amendment] will prejudice the party that has obtained the admissions." *Id.* (citation omitted). "Prejudice" is not simply that the party who initially obtained the admission will now have to convince the fact finder of its truth, but rather, relates to the special difficulties a party may face caused by the sudden need to obtain evidence upon withdrawal or amendment of admission. *Kerry Steel, Inc. v. Paragon Indus., Inc.*, 106 F.3d 147 (6th Cir. 1997) (citation omitted for clarity); *Davis v. Noufal*, 142 F.R.D. 258, 259 (D.D.C. 1992) (holding that the burden of addressing the merits does not establish "prejudice"). The "special difficulties" include the "unavailability of key witnesses in light of the delay." *Sonoda v. Cabrera*, 255 F.3d 1035, 1039 (9th Cir. 2001). Mere inconvenience by the withdrawal of admissions does not constitute "prejudice." *Hadley*, 45 F.3d at 1349.

Both prongs of this test are met and the Board should hold that E!'s admissions are withdrawn.

II. REFUSING WITHDRAWAL OF THE ADMISSIONS WILL UNDERMINE THE PRESENTATION OF THE MERITS

The present case is akin to *Giersch*, which involved a party who had served untimely responses to requests for admissions because its counsel erroneously thought that opposing counsel would grant an extension of time. The Board allowed the party to withdraw the untimely admissions. With respect to the first prong of the test, the Board indicated that allowing the admissions to stand would not promote presentation of the case on the merits. This

is because the answering party had denied most of the requests. Thus, "[i]f withdrawal thereof were not permitted, respondent would be held to have admitted critical elements of petitioners' asserted claims." *Giersch*, 2007 WL 1653585 at *3; *see also Brown & Bigelow, Inc. v. Freeflight, Inc.*, No. 102448, 1999 TTAB LEXIS 305, at *2 (T.T.A.B. July 7, 1999) (allowing withdrawal of admission because, "it is clear that if the admissions are allowed to stand, applicant, having admitted to essentially every factual element . . . would have no hope of succeeding on the merits").

Here, like in *Giersch*, allowing the "admissions" to stand could be case dispositive. Ovation served 117 requests for admissions, many of which go directly to the central factual and legal issues in this dispute. For instance, if allowed to stand, E! will have admitted the following:

No. 79: Opposer's trademark CULTUREPOP is famous.

No. 80: Opposer's trademark CULTUREPOP is well-known.

No. 82: The channels of trade of the CULTUREPOP Mark and the E POP OF CULTURE Mark are similar.

No. 84: The channels of marketing of the CULTUREPOP Mark and the E POP OF CULTURE Mark are similar.

No. 86: The targeted demographic of the CULTUREPOP Mark and the E POP OF CULTURE Mark are similar.

No. 88: The nature of the content associated with the CULTUREPOP Mark and the E POP OF CULTURE Mark are similar.

No. 89: The E POP OF CULTURE Mark is similar in appearance to Opposer's CULTUREPOP Mark.

No. 92: The E POP OF CULTURE Mark is similar in sound to Opposer's CULTUREPOP Mark.

No. 94: The E POP OF CULTURE Mark is similar in connotation to Opposer's CULTUREPOP Mark.

No. 96: The E POP OF CULTURE Mark is similar in commercial impression to Opposer's CULTUREPOP Mark.

No. 98: Applicant is aware of the existence of instances of actual confusion between the E POP OF CULTURE Mark and the CULTUREPOP Mark.

No. 100: Applicant has not used the E POP OF CULTURE Mark in connection with all of the goods set forth in the E POP OF CULTURE Application.

No. 102: Applicant has not used the E POP OF CULTURE Mark in connection with all of the goods set forth in the E POP OF CULTURE Applications.

No. 115: The CULTUREPOP mark is not descriptive of the services offered by Opposer under the mark.

(*See* Dkt. No. 26 at pp. 57-72, Ex. C to Declaration of Paul A. Bost, Opposer's First Set of Requests for Admission to Applicant E! Entertainment Television, LLC.)

These judicially created "admissions" specifically relate to the elements of the likelihood of confusion test, including elements such as the similarity of the marks, relatedness of the goods, channels of trade, fame of the prior mark, and actual confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). These "admissions" may also dispose of E!'s affirmative defense that Ovation's mark "CULTUREPOP" is descriptive of Ovation's services and goods, *i.e.* pop culture-related products or services. (Dkt. No. 5) (answer and affirmative defenses).

In sum, denying withdrawal of the admissions would not only fail to promote adjudication on the merits, but rather, would completely undermine it, contradicting the purpose of Rule 36. Fed. R. Civ. Proc. 36(b), 1970 Committee Notes ("This provision emphasizes the importance of having the action resolved on the merits, while at the same time assuring each party that justified reliance on an admission in preparation for trial will not operate to his prejudice"); *Johnston Pump/general Valve Inc.*, No. 76,991, 1989 WL 274413, at *3 (T.T.A.B.

Sept. 28, 1989) ("[e]mphasized throughout the Federal Rules of Civil Procedure is the importance of resolving actions on the merits whenever possible").

Thus, the first prong of the test is satisfied.

III. ALLOWING E! TO WITHDRAW THE ADMISSIONS WILL NOT PREJUDICE OVATION

The second prong of the test for withdrawal of admissions requires the Board to examine "whether withdrawal [or amendment] will prejudice the party that has obtained the admissions." *Giersch*, 2007 WL 1653585 at *3 (citation omitted).

For instance, in *Giersch*, the Board indicated that allowing the admissions to be withdrawn would not be prejudicial because the case was still in the pre-trial stages. Any potential prejudice could be mitigated by extending the discovery period as necessary to permit additional follow-up discovery based on respondent's amended admissions. *Id.* The Board has also held that withdrawing admissions prior to the testimony period is not prejudicial. *See Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, No. 79,928, 1990 WL 354502 (T.T.A.B. Apr. 19, 1990) (granting motion to withdraw admissions where propounding party's testimony period had not yet opened and noting that "where the failure to timely respond to a request for admissions has a harsh result" withdrawal of the admissions provides a method of relief).

Here, there is no prejudice in allowing E! to withdraw its "admissions." Like in *Giersch* and *Hobie Designs*, this proceeding is still in the discovery phase and has not proceeded to trial. (Dkt. No. 32) (resetting discovery deadline). Moreover, E! has already served its responses to Ovation's requests for admissions. Even assuming E!'s responses were late, they were late for a mere thirty days (May 9, 2014 instead of April 9, 2014) – which is a small amount of time when considered in the overall context of these consolidated proceedings. Ovation has had E!'s responses to its requests for admissions for well over a year. Indeed, if the "admissions" were

withdrawn, the Board could simply rule on Ovation's requests to test the sufficiency of E!'s responses to them without delay.

Thus, the second prong of the test is also satisfied.

CONCLUSION

For the foregoing reasons, E! respectfully request that the Board enter an order deeming E!'s "admissions" to Ovation's February 12, 2014 requests for admissions withdrawn.

Dated: this 11th day of September, 2015.

LEWIS ROCA ROTHGERBER

By: /s/ Jonathan W. Fountain
Michael J. McCue
Jonathan W. Fountain
3993 Howard Hughes Parkway, Suite 600
Las Vegas, NV 89169-5996
(Tel.) 702-949-8200
(Fax) 702-949-8398

Attorneys for Applicant
E! Entertainment Television, LLC

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that a true and complete copy of the foregoing **APPLICANT E! ENTERTAINMENT TELEVISION, LLC'S MOTION FOR LEAVE TO WITHDRAW ADMISSIONS** is being transmitted electronically with the United States Patent and Trademark Office, Trademark Trial and Appeal Board, through ESTTA at http://estta.uspto.gov on September 11, 2015.

/s/ Joy A. Jones
An employee of Lewis Roca Rothgerber LLP

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **APPLICANT E! ENTERTAINMENT TELEVISION, LLC'S MOTION FOR LEAVE TO WITHDRAW ADMISSIONS** has been served on attorneys for Opposer, by mailing a copy on September 11, 2015, via First Class Mail, postage prepaid, to:

Jill M. Pietrini, Esq.
Whitney Walters, Esq.
Paul A. Bost, Esq.
Sheppard Mullin Richter & Hampton LLP
1901 Avenue of the Stars, Suite 1600
Los Angeles, CA 90067-6017

/s/ Joy A. Jones, CP
An employee of Lewis and Roca LLP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

OVATION, LLC, a Delaware limited liability company, Opposer, v. E! ENTERTAINMENT TELEVISION, LLC, a Delaware limited liability company, Applicant.	**Opposition No. 91210506 (parent)** Application No. 85/569,798 Mark: POP OF CULTURE **Opposition No. 91217286** Application No. 85/937,423 Mark: E POP OF CULTURE **Opposition No. 91217287** Application No. 85/937,399 Mark: E POP OF CULTURE

DECLARATION OF JONATHAN W. FOUNTAIN

I, Jonathan W. Fountain, declare under penalty of perjury under the laws of the United States that the following is true and correct:

1. I am an employee of Lewis Roca Rothgerber LLP, counsel for Applicant E! Entertainment Television LLC ("Applicant" and/or "E!"). This declaration is based upon my own personal knowledge and I am competent to testify to the facts set forth herein.

2. E! is a corporate affiliate of NBCUniversal Media, LLC and the owner of the popular E! Entertainment cable television network.

3. E! is an American cable and satellite television channel that features programming about entertainment, the entertainment industry, and pop culture in general. POP OF CULTURE is E!'s tagline and slogan. E!'s adoption of the POP OF CULTURE logo followed a re-branding of the company and was introduced on July 9, 2012.

4. Ovation alleged that POP OF CULTURE is likely to be confused with a

designation it uses for the name of a show about pop culture -- CULTUREPOP. Ovation filed a Notice of Opposition to E!'s application for POP OF CULTURE on April 29, 2013. On July 9, 2014, Ovation filed Notices of Opposition to two of E!'s applications to register the E POP OF CULTURE mark. On October 11, 2014, these three opposition proceedings were consolidated.

5. On November 12, 2013, E! served a set of discovery requests on Ovation.

6. On January 24, 2014, Ovation served E! with 33 interrogatories and 82 requests for the production of documents. Shortly thereafter, on February 12, 2014, Ovation served E! with 117 requests for admissions.

7. Between November 2013 and March 2014, E!'s counsel and Ovation's counsel granted each other numerous reciprocal extensions of time to respond to the pending discovery requests to accommodate ongoing settlement discussions. E!'s motion to compel, filed on April 9, 2014, detailed these extensive discussions. (Dkt. No. 13.)

8. On February 14, 2014, E!'s counsel emailed Ovation's counsel, and proposed that the parties discuss settlement and the need for discovery responses from both parties. (*Id*., Ex. A to Declaration of Michael J. McCue In Support of Applicant's Motion to Compel.) In that email, E!'s counsel, Mr. McCue, proposed a suspension of the proceedings to allow the parties to engage in settlement, including a proposal that E! would serve its responses to "Ovation's **first set** of written discovery requests" within 45 days after proceedings resume. (*Id.*) (Emphasis added.) After receiving no response, E!'s counsel followed up regarding this request on February 24, 2014, March 14, 2014, and March 27, 2014. (*Id.*) In his March 27 email, E!'s counsel asked for an extension of time to "respond to Ovation's **discovery requests**" from April 4 to April 29, while E! waited for a response on the proposed settlement procedures. (*Id.*) (Emphasis added.) Finally, on March 28, 2014, Ovation replied that it would prefer to have the responses to Ovation's discovery requests, including E!'s responses to Ovation's requests for

admissions, before discussing settlement. (*Id.*) Ovation offered to give E! an extension of time of 5 days to respond to its discovery requests from April 4 to April 9, 2014. (*Id.*)

9. On March 31, 2014, E!'s counsel conveyed his dismay over Ovation's refusal to grant a longer extension of time. (*Id.*) However, E!'s counsel accepted the April 9, 2014 extension of time to respond to all of Ovation's outstanding discovery requests, including its requests for admissions. (*Id.*)

10. On April 9, 2014, E! filed a motion to compel Ovation to serve responses to E!'s discovery requests, and also asked the Board to grant E! an extension of time "to serve its written objections and responses to Opposer's discovery requests by 30 days." (Dkt. No. 13 at 2) E!'s motion stated that it sought an extension of time for the "January 24, 2014" discovery requests. (*Id*.) As noted above, however, the first set of requests for admissions were served on February 12, 2014, apart from the interrogatories and request for the production of documents that had been served on January 24, 2014.

11. Ostensibly, it would appear that E! did not request an extension of time for responding to Ovation's 117 requests for admissions, but this was an inadvertent oversight. As seen from the email communications leading to E!'s motion seeking an extension of time, it was clear that E! sought an extension of time from Ovation to respond to Ovation's entire "first set" of discovery requests, which included Ovation's requests for admissions. (*See* Dkt. No. 13, Ex. A to McCue Decl., Feb. 14, 2014 Email from McCue to Pietrini.) Indeed, Ovation clearly thought the same thing, as Ovation granted E!'s request for an extension of time to respond to all of Ovation's outstanding discovery responses, from April 4 to April 9. (*See* Dkt. No. 13, Ex. A to McCue Decl., March 28, 2014 Email from Walters to McCue; *see also* Dkt. No. 26, Ovation's Motion to Compel at n. 1 (arguing that E! did not timely respond by April 9, 2014).)

12. When Ovation refused to grant E! the extension of time it had asked for, E!

intended to ask the Board for the same relief – an extension of time to respond to **all** of Ovation's outstanding discovery requests, including Ovation's requests for admissions. However, E!'s counsel who drafted E!'s motion to compel and request for an extension of time for E! to respond to Ovation's "first set" of discovery requests inadvertently referred to the requests served on January 24, 2014 -- did not realize that the requests for admission had been served on a different date, February 12, 2014.

13. The Board eventually granted E!'s request for an extension of time. (Dkt. No. 18.) Consistent with the belief that E! asked for, and was granted, an extension of time to respond to **all** of Ovation's discovery requests, including the 117 requests for admissions, E! served its responses to Ovation's discovery requests, including its responses to the requests for admissions, within the time provided for by the Board (*i.e.*, on May 9, 2014).

14. On April 3, 2015, Ovation filed a motion to compel. (Dkt. No. 26.) In the motion, Ovation asked the Board to test the sufficiency of E!'s May 9, 2014 responses to Ovation's requests for admissions. (*Id.*) In a footnote, in the "factual background" section of the motion, Ovation noted that by seeking to test the sufficiency of the responses, Ovation did not waive its right to argue that E!'s responses were untimely because E! had not "expressly" sought an extension of time to respond to Ovation's requests for admissions because E!'s motion only specifically referenced the discovery Ovation served on "January 24":

> On July 31, 2014, the Board granted Applicant's motion over Opposer's opposition. (Docket No. 18.) This motion should not be construed as Opposer's waiver or rescission of the position it expressed in its opposition to Applicant's motion, that is, that Applicant waived its right to object to Opposer's discovery requests for its failure to serve timely responses. Furthermore, Applicant did not expressly seek any relief with respect to Opposer's RFAs or Applicant's responses thereto. Nowhere in its motion does Applicant refer to Opposer's RFAs, and, in fact, Opposer expressly only sought an extension of its deadline to respond to Opposer's "January 24, 2014 discovery requests," not Opposer's RFAs, which were served on February 12, 2014. (Docket No. 13, p. 22.) Thus, Opposer believes that, as a matter of law, each of Opposer's RFAs are deemed

> admitted for Applicant's failure to serve timely responses by April 9, 2014. *See* Fed.R.Civ.P. 36(a)(3). Opposer's instant motion to test the sufficiency of Applicants responses to certain of Opposer's RFA should not be construed as a waiver of Opposer's positon [*sic*].

(Dkt. No. 26 at fn. 1.)

15. However, Ovation did not request that the Board find that Ovation's requests for admissions should be deemed admitted because E! had served untimely responses to the requests for admissions.

16. E! responded on the merits to Ovation's request to test the sufficiency of E!'s responses. (Dkt. No. 30.) E! noted that it believed the Board's previously granted extension of time for E! to respond to Ovation's discovery requests included an extension of time to respond to all of Ovation's outstanding discovery requests, including the requests for admissions. (Dkt. No. 30 at n. 1.)

17. On September 2, 2015, the Board issued its decision on Ovation's motion to compel. (Dkt. No. 32.) The Board held Ovation's motion to test the sufficiency of E!'s responses to Ovation's requests for admissions moot because, by failing to serve timely responses, E! had admitted the truth of the requests. The Board's order states the following:

> ***Here, because Applicant did not serve its responses to Opposer's requests for admission until May 9, 2014, rather than April 9, 2014, and Applicant's motion to extend time did not apply to Opposer's requests for admission, Opposer's requests are deemed admitted.*** Fed. R. Civ. P. 36(a)(3). In view thereof, there was no need for Opposer to file its motion to test the sufficiency of Applicant's responses as they are not the operative responses in this matter… Accordingly, Opposer's motion to test the sufficiency of Applicant's responses is moot and will be given no further consideration.

(Dkt. No. 32 at 4) (emphasis added).

Executed on: September 11, 2015.

/s/ Jonathan W. Fountain
(Signature)

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that a true and complete copy of the foregoing DECLARATION OF JONATHAN W. FOUNTAIN is being transmitted electronically with the United States Patent and Trademark Office, Trademark Trial and Appeal Board, through ESTTA at http://estta.uspto.gov on September 11, 2015.

/s/ Joy A. Jones, CP
An employee of Lewis and Roca LLP

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing DECLARATION OF JONATHAN W. FOUNTAIN has been served on attorneys for Opposer, by mailing a copy on September 11, 2015, via First Class Mail, postage prepaid, to:

Jill M. Pietrini, Esq.
Whitney Walters, Esq.
Paul A. Bost, Esq.
Sheppard Mullin Richter & Hampton LLP
1901 Avenue of the Stars, Suite 1600
Los Angeles, CA 90067-6017

/s/ Joy A. Jones, CP
An employee of Lewis and Roca LLP